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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,667	01/18/2002	Paul M. Magee	82306JLT	1164

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EXAMINER

LE, HOA VAN

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 01/30/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/051,667

Applicant(s)

MAGEE ET AL.

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 01 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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This application is before the examiner for consideration.

A. An independent claim, such as claim 1, is considered as the main invention for its groups of the claims, such 1-19. A dependent claim, such as claim 2, or a group of the dependent claims, such as claims 2-19 is considered as secondary embodiment(s) and allowed to be rejoined with its elected, considered, searched and found to be allowable main invention of the independent claim.

B. A process or method claim is permitted to be rejoined with an elected, considered, searched and allowable material claim provided the process or method claim must be contained all of the limitations of the allowable material claim in accordance with the authority stated in *In re Ochiai*, 37 USPQ2d 1127 or *In re Brouwer*, 37 USPQ2d 1663 and MPEP 821.04.

C. I. Claims 1-19 are generic to a plurality of disclosed patentably distinct species comprising (1) many possible species of the general formula I, (2) many possible species of the general formula II, (3) an amount sufficient to inhibit a sludge deposition, (4) 0,000 007 to 0, 007 mol/l, (5) many possible species of the general formula III, (6) any concentration of a compound of the general formula III, (7) 0,000 02 to 0,005 mol/l, (8) many possible thiol promoting compounds, (9) water-soluble silver salt, (10) water-insoluble silver salt, (11) any amount of a sugar derivative, (12) 0,000 2 to 0,07 mol/l, (13) any amount of a mercaptocarboxylic acid, (14) 0,000 02 to 0,02 mol/l of a mercaptocarboxylic acid, (15) 0, 000 02 to 0,02 mol/l of a compound

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of a general formula III, (16) dihydroxybenzene, (17) ascorbic acid, (18) no auxiliary super-additive developing agent, (19) auxiliary per-additive developing agent, (20) no sulfite and (21) sulfite. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search, even though this requirement is traversed. If applicants elect item (1), (2), (5) or (8) above, they are required to further elect its sub-species such as MTA and its defined substitutions, such as those on page 21, lines 20-21.

II. Claims 20-21 are provisionally generic to a plurality of disclosed patentably distinct species comprising (1) many possible species of the general formula I, (2) many possible species of the general formula II, (3) an amount sufficient to inhibit a sludge deposition, (4) 0,000 007 to 0, 007 mol/l, (5) many possible species of the general formula III, (6) any concentration of a compound of the general formula III, (7) 0,000 02 to 0,005 mol/l, (8) many possible thiol promoting compounds, (9) water-soluble silver salt, (10) water-insoluble silver salt, (11) any amount of a sugar derivative, (12) 0,000 2 to 0,07 mol/l, (13) any amount of a mercaptocarboxylic acid, (14) 0,000 02 to 0,02 mol/l of a mercaptocarboxylic acid, (15) 0, 000 02 to 0,02 mol/l of a compound of a general formula III, (16) dihydroxybenzene, (17) ascorbic acid, (18) no auxiliary super-additive developing agent, (19) auxiliary per-additive developing agent, (20) no sulfite, (21) sulfite, (22) a compound of the general formula I being in a developer, (23) a compound of the general formula I being in a silver halide photographic material, (24) a compound of the general formula II being in a developer and (25) a compound of the general formula II being in a silver halide photographic material. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search, even though this requirement is traversed. If applicants elect item (1), (2), (5) or (8) above, they are required to

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further elect its sub-species such as MTA and its defined substitutions, such as those on page 21, lines 20-21.

III. Claims 22-23 are provisionally generic to a plurality of disclosed patentably distinct species comprising (1) many possible species of the general formula I, (2) many possible species of the general formula II, (3) an amount sufficient to inhibit a sludge deposition, (4) 0,000 007 to 0, 007 mol/l, (5) many possible species of the general formula III, (6) any concentration of a compound of the general formula III, (7) 0,000 02 to 0,005 mol/l, (8) many possible thiol promoting compounds, (9) any amount of a sugar derivative, (10) 0,000 2 to 0,07 mol/l, (11) any amount of a mercaptocarboxylic acid, (12) 0,000 02 to 0,02 mol/l of a mercaptocarboxylic acid and (13) 0, 000 02 to 0,02 mol/l of a compound of a general formula III. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search, even though this requirement is traversed. If applicants elect item (1), (2), (5) or (8) above, they are required to further elect its sub-species such as MTA and its defined substitutions, such as those on page 21, lines 20-21.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

D. Restriction to one of the following inventions is required under 35 U.S.C. 121:

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- I. Claims 1-19, drawn to a developer, classified in class 430, subclass 488.
- II. Claims 20-21, drawn to a developing process, classified in class 430, subclass 434.
- III. Claims 22-23, drawn to a photographic material, classified in class 430, subclass 611.

Inventions of Group I and Group III are all related to the material but are patentably different and distinct each from the other because they have acquired the separate status and searches in the art and can be supported the separate patents as divided by applicants and there is no evidence on the record that they are not required the separate consideration and search since they are the obvious variants because the prior art being applied to one invention would be sufficient against all of the above inventions. Therefore, separate consideration of search is required. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

The inventions of Groups (I and III) and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP 806.05(h)). In the instant case, the process for developing a silver halide photographic material as claimed can be practiced with another materially different product such as using a known and patentably distinct anti-sludging

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agent as those known in the art. Applicants should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

Because these inventions are distinct for the reasons given above and have acquired the separate status in the art and can support the separate patents as divided by applicants and have no evidence of the record that they are not patentably different or distinct and are the obvious variants under 35 U.S.C. 103 to one having ordinary skill in the art since no separate consideration or search is necessitated or required because a prior art being applied against one invention is sufficient against all of them, restriction for examination purposes as indicated is proper.

E. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

F. Applicants' prior art submissions and foreign priority document filed on 18 January 2002 have been entered in the file application.

G. Other issues are not now considered until a proper election is made and resolved.

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H. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 703-308-2295. The examiner can normally be reached on 6:30AM-5:00PM, M-TH.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on 703-308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7172 for regular communications and 703-746-7172 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Hoa V. Le  
Primary Examiner  
Art Unit 1752

HVL  
27 January 2003

HOA VAN LE  
PRIMARY EXAMINER

